

Attorney Docket No. 112.P77196

Patent Application No. 10/707,353

REMARKS

The present patent application has been reviewed in light of the Office Action mailed April 20, 2007, in which claims 1, 3-5, and 7-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Watkins, U.S. Patent No. 6,859,609 (hereinafter "Watkins") in view of Sarbadhikari et al., U.S. Patent No. 5,477,264 (hereinafter "Sarbadhikari"); claim 2 is rejected under 35 U.S.C. §103(a) over Watkins in view of Sarbadhikari and in further view of Sasson et al., U.S. Patent No. 5,016,107 (hereinafter "Sasson"); and claim 6 is rejected under 35 U.S.C. §103(a) over Watkins in view of Sarbadhikari and in further view of Klein, U.S. Patent Application Publication No. 2002/0023206 (hereinafter "Klein"). Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-31 are pending. Claims 1-13 have been amended. New claims 14-31 have been added. No new matter has been added. Support for new claims 14-31 may be found, for example, at least at Figures 1-3.

In the Office Action, the Examiner noted that parentheses are improper in claims 1, 6, and 10. Claims 1, 6, and 10 have been amended to remove the parentheses. Assignee submits that these amendments do not impact the scope of claimed subject matter, and no prosecution history estoppel should apply.

Attorney Docket No. 112.P77196

Patent Application No. 10/707,353

Claim Rejections under 35 U.S.C. § 103

Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Watkins, Sarbadhikari, Sasson, and Klein. Assignee respectfully traverses the rejections.

The Examiner is reminded that to successfully make a prima facie rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See KSR International, Co. v. Teleflex, Inc., 550 U.S. ____ (decided April 30, 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See USPTO Memo entitled "Supreme Court decision on KSR Int'l. Co., v. Teleflex, Inc." (May 3, 2007). One way in which an Examiner may establish a prima facie case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the

Attorney Docket No. 112.P77196

Patent Application No. 10/707,353

reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See MPEP § 2142; § 2143 - § 2143.03 (regarding decisions pertinent to each of these criteria). It is respectfully asserted that the Examiner has not met these standards. The applied documents, whether applied individually or in combination, do not teach or suggest all of the elements of the aforementioned claims.

In the Office Action, the Examiner contends that Watkins discloses a method for optimizing audiovisual signals. However, Watkins does not disclose "storing an audiovisual processing program in the non-removable memory of the audiovisual capturing device, wherein the audiovisual processing program is configured to be transferred to a host computer and is further configured to be executed on the host computer" as recited in amended claim 1.

Also in the Office Action, the Examiner contends that Sarbadhikari discloses executing the optimization program by a host computer after connecting a memory device to the host computer. However, Sarbadhikari does not disclose "storing an audiovisual processing program in the non-removable memory of the audiovisual capturing device, wherein the audiovisual processing program is configured to be transferred to a host computer and is further configured to be executed on the host computer" as recited in amended claim 1.

Similarly, neither Sasson nor Klein disclose "storing an audiovisual processing program in the non-removable memory of the audiovisual capturing device, wherein the audiovisual processing program is configured to be transferred to a host computer and

Attorney Docket No. 112.P77196

Patent Application No. 10/707,353

is further configured to be executed on the host computer" as recited in amended claim 1.

Therefore, any combination of Watkins, Sarbadhikari, Sasson, and/or Klein would not yield "storing an audiovisual processing program in the non-removable memory of the audiovisual capturing device, wherein the audiovisual processing program is configured to be transferred to a host computer and is further configured to be executed on the host computer" as recited in amended claim 1. Accordingly, Assignee respectfully submits that claim 1, as well as claims 2-9 depending therefrom, distinguish over any purported combination of Watkins, Sarbadhikari, Sasson, and/or Klein, whether or not such combination is properly made. Assignee therefore respectfully requests withdrawal of the rejections of these claims.

Similarly, neither Watkins, nor Sarbadhikari, nor Sasson, nor Klein, either alone or in combination, disclose "a removable memory having stored thereon an audiovisual processing program capable of being executed by a host computer in response to connecting the audiovisual device to the host computer" as recited in amended claim 10. Accordingly, Assignee respectfully submits that claim 10, as well as claims 11-13 depending therefrom, distinguish over any purported combination of Watkins, Sarbadhikari, Sasson, and/or Klein, whether or not such combination is properly made. Assignee therefore respectfully requests withdrawal of the rejections of these claims.

It is noted that claimed subject matter may be patentably distinguished from the applied documents for additional reasons; however, the foregoing is believed to be sufficient to overcome the Examiner's rejections discussed above.

Attorney Docket No. 112.P77196

Patent Application No. 10/707,353

Further, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions since the Examiner's other positions are believed to be moot in light of the foregoing.

Attorney Docket No. 112.P77196

Patent Application No. 10/707,353

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Entry of this amendment and reconsideration of the present patent application in view of the same and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. No. 50-3703.

Respectfully submitted,

Dated: 9/20/07By /Calvin E. Wells Reg. No. 43,256/
Calvin E. Wells,
Registration No. 43,256

Customer No. 43831
Berkeley Law and Technology Group, LLP
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
Phone: 503.439.6500

09/21/2007 VBU111 00000025 503703 10707353
02 FC:1201 200.00 DA
03 FC:1202 550.00 DA